

Amendment under 37 C.F.R. §1.111
Application No. 10/656,114
Attorney Docket No. 031004

REMARKS

Claims 1-13 are pending. Claims 1-3, 7, 9 and 12 have been amended herein. Support for the amendments is found at page 7, paragraph [0014]; page 10, paragraph [0020]; Fig. 3 and as set forth below.

Applicant's Response to the Claim Objections

Claims 2, 7 and 9 stand objected to for informalities in regard to proper antecedent basis. In response thereto, applicant has amended the claims in accordance with the suggestions set forth in the Office Action.

Applicant's Response to the Claim Rejections under 35 U.S.C. §102

Claims 1, 3, 11 and 12 stand rejected under 35 U.S.C. §102(b) as being anticipated by Murata (Japanese Publication number 2001-186301). In response thereto, applicant has amended claims 1, 3 and 12 to include the feature of the present invention that the screen file is accessed from a location other than the prescribed device. This amendment incorporates features from original claim 6 which are not taught or suggested by Murata. Wherefore, applicant respectfully submits that the rejection is now moot.

Applicant's Response to the Claim Rejections under 35 U.S.C. §103

Claim 6 is rejected under 35 U.S.C. §103(a) as being unpatentable over Murata (Japanese Publication number 2001-186301) in view of Kley (US patent 6947977). As noted above, applicants have included the feature of original claim 6 into independent claims 1, 3 and 12 requiring that the screen file is accessed from a location other than the prescribed device. Applicant respectfully traverses on the basis that limitations of amended claims 1, 3 and 12 are not recited in as clear detail as claimed by applicants and that one of skill in the art would not be motivated to derive the current invention based on the teachings of the combined references.

Under U.S. patent law, a *prima facie* case of obviousness is established only if there is a teaching or motivation which would lead the skilled artisan to make the combination of references cited to derive the invention as claimed. In the current instance there is no motivation provided by Kley or Murata to adopt a system for communicating web pages requested by clients to the client access as taught by Kley to a MFT system of Murata so as to derive the current invention.

First, applicant notes that each and every limitation of the claimed invention must be taught in as complete detail as it is claimed by the applicants. In the current instance claims 1, 3 and 12 require, pursuant to their respective terminology, a destination accepting unit which accepts information for specifying the prescribed apparatus intended to set the configuration data, as destination identification information. In regard to this limitation, the Office states that Murata discloses at paragraph [0005] "the device settings are changed from a browser on the

client, the device must have been specified and identified, and the unit to do this is the client.”
See page 3 of the current Office Action. However, there is no recitation cited to in Murata or in any of the other prior art which indicates that the client in fact has “a destination accepting unit.”

As set forth in applicant’s specification, a purpose of the invention is to allow a prescribed apparatus, such as a fax machine or scanner which has limited memory capability to utilize a user friendly screen file (i.e. a screen file requiring a considerable amount of memory) without maintaining the screen file in the limited memory of the prescribed apparatus. In order to do so, a destination accepting unit is provided in the screen file so that the prescribed apparatus is locatable. Murata does not teach or suggest this feature as claimed by applicant. Murata is directed to the use of a browser to communicate with a MFT. There is no clear indication provided in the reference that the client has a destination accepting unit as required by applicant’s claims 1, 3 and 12 according to their respective terminology.

Further, applicants have amended the claims to clarify that accepting unit is configured to accept the screen file from a third apparatus, such as a server or portable memory device. In regard to this limitation of claim 6, the Office asserts that Kley teaches a web server which provides screen files from a web server to a client which accepts the file and uses a communication network. The Office maintains that it would be obvious to one of ordinary skill in the art to modify Murata to include the use of a remote recording medium “in order to communicate web pages requested by the clients back to the requesting client system.” See pages 7-8 of the current Office Action.

However, there is no teaching or suggestion of a third apparatus in either of the cited references of Murata or Kley wherein a screen file is saved in the third apparatus and the destination identification information is required. Kley is directed to only a two way communication between the user system and the server. Kley does not teach that the screen file is stored on a third apparatus and the terminal device utilizes a destination accepting unit in order to communicate with the prescribed apparatus.

The Office Action states that “the general concept of providing a way to send a screen file via a communication network is well known in the art as illustrated by Kley”. See page 7 of the Office Action. However, applicant’s invention as set forth above requires more than the general concepts of the cited reference to be derived. As set forth in M.P.E.P. §2141.02 II distilling an invention down to the “gist” or “thrust” of an invention disregards the requirement of analyzing the subject matter “as a whole.” In the current instance, applicants respectfully submit that the limitations of the destination accepting unit and the screen file accepting unit accepting the screen file from other than the prescribed apparatus are not conveyed in the cited prior art in as clear and detailed a manner as claimed. Kley and Murata at most disclose the gist of these limitations and combining them to reach the current invention as set forth in the amended independent claims would not have been obvious, because the skilled artisan would lack proper motivation. Wherefore, applicants respectfully submit that amended claims 1, 3 and 12 including in part a limitation from claim 6 would not be obvious in light of Murata and Kley.

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Claims 2 and 9 are rejected under 35 U.S.C. §103(a) as being unpatentable over Murata in view of Bates (US patent 6963901). Claims 4 and 13 are rejected under 35 U.S.C. §103(a) as being unpatentable over Murata in view of Weghorst (US patent 6775559). Claims 5 is rejected under 35 U.S.C. §103(a) as being unpatentable over Murata in view of Kley (US patent 6947977). Claim 7 is rejected under 35 U.S.C. §103(a) as being unpatentable over Murata in view of Harvey (US patent 7054924). Claim 8 is rejected under 35 U.S.C. §103(a) as being unpatentable over Murata in view of Fields (US patent 6412008). Claim 10 is rejected under 35 U.S.C. §103(a) as being unpatentable over Murata in view of Harrison (US patent 6434502). Applicant notes that these rejections are all based upon the rejection of the independent claims 1, 3 and 12 as being anticipated by Murata. Applicant respectfully submits that by addressing the rejection of the patent claims, as detailed above, the rejection of the dependent claims is likewise addressed by nature of the claims' dependencies.


In view of the aforementioned amendments and accompanying remarks, Applicants submit that the claims, as herein amended, are in condition for allowance. Applicants request such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney to arrange for an interview to expedite the disposition of this case.

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If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,
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